Atty Docket No.: OIN 1012-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Group Art Unit: 2176
Matthew D. FUCHS et al.	
Application No.: 09/493,517	Examiner: Maikhanh NGUYEN
Confirmation No.: 2359	CUSTOMER NO. 22470
Filed: 28 January 2000	
Title: SYSTEM AND METHOD FOR SCHEMA EVOLUTION IN AN E-COMMERCE NETWORK	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT OF SUBSTANCE OF INTERVIEW

Sir:

Applicants requested and were granted a telephonic interview with Examiner
Maikhanh Nguyen and Primary Examiner William Bashore on September 6, 2007. This
document summarizes the interview.

Prior to the interview, we submitted a proposed agenda, the substance of which
is reproduced below:

> "The spirit of this interview is to advance the case towards allowance. The
> last correspondence in this case was the Office Action that the Examiner
> mailed 30 May 2007. Applicants are prepared to offer amendments after
> discussion of the Examiner's suggestions, if necessary. Applicants would
> like to discuss with the Examiner the best way to advance this case
> towards allowance.

During the interview, Applicants hope to discuss the technology disclosed and what the cited Call reference discloses, and also discuss:

1. How the Examiner is responding to the positions taken on pages 7-11 of the response that we mailed on March 7, 2007? In particular:

a. What way of achieving extensibility does the Examiner see being enabled and described by Call in column 25? (No enablement or written description position, p. 7)

b. How does the Examiner weigh the teaching away in W3C's Resource Development Framework ("RDF") Schema specification, to which we refer in the middle of page 8?

c. Has the Examiner reviewed references other than Call that explain how RDF really works? What references has the Examiner looked at, so we can look at the same?

2. What structures does the Examiner consider to be referenced by the means-plus-function language of claim 25? (No prima facie case position, pp. 10-11).

3. What is it about the wording of our claim that seems so broad to the Examiner as reading on the RDF technology for capturing and categorizing the semantic content of catalog items? How can the claims be clarified to read on extending a transaction schema without abandoning or breaking the schema that is being extended, but not mapping the semantics of catalog items?"

During the interview we largely followed the agenda. We focused on the Call reference. The Examiner agreed to fully consider our arguments filed on August 30, 2006.

Regarding 1(a), the Examiners suggested that enablement is presumed. Applicants pointed out that the statutory presumption of validity applies only to the claims, not to enablement in every paragraph of the disclosure other than the claims. We used the example of a description of tomato soup appearing in the disclosure of a computer device. There should not be any presumption attaching to the soup recipe, not a presumption of enablement or that the soup would be tasty. Any presumption would easily be turned aside by Applicants' comments. Support for Applicants' position is found in the treatise by Professor Chisum, at § 3.04[1][b][v]:

"In patent prosecution the examiner is entitled to reject application claims as anticipated by a prior art patent without conducting an inquiry into whether or not that patent is enabled or whether or not it is the claimed material (as opposed to the unclaimed disclosures) in that patent that are at issue... *In re*

Sasse, 629 F.2d 675, 681, 207 USPQ 107, 111 (C.C.P.A.1980) ('[W]hen the PTO cited a disclosure which expressly anticipated the present invention ... the burden was shifted to the applicant. He had to rebut the presumption of the operability of [the prior art patent] by a preponderance of the evidence.' (citation omitted)). The applicant, however, can then overcome that rejection by proving that the relevant disclosures of the prior art patent are not enabled... We hold that an accused infringer should be similarly entitled to have the district court presume the enablement of unclaimed (and claimed) material in a prior art patent defendant asserts against a plaintiff. Thus, a court cannot ignore an asserted prior art patent in evaluating a defense of invalidity for anticipation, just because the accused infringer has not proven it enabled. Like the applicant in *ex parte* prosecution, however, the patentee may argue that the relevant claimed or unclaimed disclosures of a prior art patent are not enabled and therefore are not pertinent prior art. If a patentee presents evidence of nonenablement that a trial court finds persuasive, the trial court must then exclude that particular prior art patent in any anticipation inquiry, for then the presumption has been overcome."

1-3 Chisum on Patents (2007 online supplement) *quoting Amgen Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1355 (Fed. Cir. 2003).

In this case, we commented that Call col. 25 is silent and does not present any way of accomplishing the goal of extensibility. That is enough to rebut the presumption that Call is enabling as to any particular way of accomplishing extensibility.

Regarding RDF in general, we emphasized that we presented the full RDF specification to the Examiner and quoted from it as teaching away from our way of extending XML schemas (as opposed to XML documents, themselves.) Addressing whether Call enables a particular way of extending schemas is one way for us to press the point that Call does not disclose any way in which RDF accomplishes extensibility. It is not very productive for us to argue about the meaning of a brief summary in Call of a 50 page specification, when we have the specification in hand and can rely on the original document instead of Call's summary. We urged the Examiner to rely on the original source document instead of the brief summary.

In our view, RDF is intended for semantic mapping, as is needed for artificial intelligence processors to distinguish among objects. Semantic mapping is an entirely different field of endeavour than improving on features of schemas that can be used to verify the correctness of XML documents.

One additional issue mentioned was how XML documents are formed, with some elements extending other elements. While this is true, the focus of these claims is XML

schemas, not XML documents. The touchstone for the Examiner's analysis should be whether the specifications for DTDs or XML Schema or SOX taught the claimed feature before it was invented by Applicants. The Examiner should be looking at the various schema languages for XML documents, as the primary source of relevant art. The book Sall, "XML Family of Specifications, A Practical Guide", which Examiner Bashore keeps in his office, should be a handy place to look. In this book, XML Schema and alternatives are discussed at length in Chapter 6. DTD, as a predecessor to XML Schema is described in Chapter 4. (Chapter 16 describes RDF technology in much more useful detail than Call.)

At the conclusion of the interview, it was agreed that Examiner Nguyen would prepare a more extensive interview summary than usual, including responses to our questions listed above. We hope that providing this summary before receiving the Examiner's summary will help her in proceeding as agreed.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Fee Authorization. The Commissioner is hereby authorized to charge any additional fees determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (OIN 1012-1).

Respectfully submitted,

Dated: 8 September 2007   ____/Ernest J. Beffel, Jr./____
                                           Ernest J. Beffel, Jr.
                                           Registration No. 43,489

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263